

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** ALAN H. SIMPSON

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Appeal No. 1999-0515  
Application No. 08/620,256

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ON BRIEF

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Before CALVERT, ABRAMS, and BAHR, ***Administrative Patent Judges.***

ABRAMS, ***Administrative Patent Judge.***

**DECISION ON APPEAL**

This is an appeal from the decision of the examiner finally rejecting claims 1-20, which constitute all of the claims of record in the application.

The appellant's invention is directed to a spinning baseball device. The subject matter before us on appeal is illustrated by reference to claim 1, which reads as follows:

1. A spinning baseball device comprising:

a. a ball having the surface appearance of a seamed ball that is typically pitched, and said ball made of lightweight material, and

b. a plurality of bores with {sic: within] said ball, all said bores appearing at said ball's surface at different but specific and intended locations, each said bore appearing at said ball's surface only once, and

c. a spindle of sufficient length and small enough diameter so that after placing said spindle into said bore, there remains sufficient length of said spindle outside the ball and said spindle's diameter is sufficiently small so that said spindle can be placed inside of and held tight by a chuck of an electric drill, and

d. means to prevent slippage between said spindle and a bore during operation of the device.

#### THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Sain

3,152,803

Oct.

13, 1964

German Offenlegungsschrift 2,113,601  
1972<sup>1</sup>  
(Nowak)

Sep. 28,

### **THE REJECTIONS**

Claims 1-20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 1-20 also stand rejected under 35 U.S.C. § 103 as being unpatentable over Nowak<sup>2</sup> in view of Sain.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and the appellant regarding the rejections, we make reference to the Examiner's Answer (Paper No. 10) and to the Appellant's Briefs (Papers No. 9 and 11).

### **OPINION**

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<sup>1</sup> A copy of a PTO translation of this reference is enclosed.

<sup>2</sup> Called "Ols" by the examiner.

The objective of the appellant's invention is to teach batters to recognize the various spins that are placed on thrown baseballs by pitchers, such as fastballs, curveballs, and sliders, without actually pitching the ball. This is accomplished by attaching a ball device to an electric drill in a manner that imparts the various spins to the ball so they can be visualized by a potential batter, and the invention is directed to such a ball device.

*The Rejection Under 35 U.S.C. § 112, Second Paragraph*

While the appellant is free to claim his invention in broad terms and is entitled to the broadest reasonable interpretation of the claim language, because a patentee has the right to exclude others from making, using and selling the invention covered by the patent, the public must be apprised of exactly what the patent covers, so that those who would approach the area circumscribed by the claims of a patent may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. It is to this that the second paragraph of 35 U.S.C. § 112 is directed (see *In re Hammack*, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970)), and it is on the basis of this that we have evaluated the examiner's Section 112 rejection.

The examiner has cited several instances which are believed to give rise to indefiniteness in the claims. The first two of these concern the use of the terms "spinning baseball" and "typically pitched," which appear in independent claims 1 and 11. In our view, neither of these terms is

indefinite in that the invention clearly is for the purpose of causing a baseball device to spin, and the baseball device that is caused to spin has the surface appearance of a ball that is typically pitched in playing the game, that is, a regulation ball for the particular league in which the spinning baseball device is to be used for training. Otherwise, the invention would not be operable for its intended purpose, which is training batters to recognize the spin on a ball that is pitched to them.

As explained on page 9 of the appellant's specification, practice space can be saved by using a ball that is smaller than a regulation ball, so that the distance between the spinning ball and the batter can be shortened while still giving the batter the appearance of a ball that is farther away. This does not render claim 3 *et al.* indefinite.

Likewise, the items cited by the examiner in claims 4 and 5 with regard to the surface appearance and size of a softball in this invention directed to a "spinning baseball device" would have been understood by one of ordinary skill in the art and do not render the claims indefinite.

The rejection under Section 112 is not sustained.<sup>3</sup>

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<sup>3</sup>The examiner's objection to the drawings is not before us for resolution in that it is not an appealable matter (see Section 1201 of the Manual of Patent Examining Procedure). We wish to point out, however, that the challenged feature is recited in the original claims, and appears to be present in Figures 2 and 3.

*The Rejection Under 35 U.S.C. § 103*

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, ***In re Keller***, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See ***Ex parte Clapp***, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, ***Uniroyal, Inc. v. Rudkin-Wiley Corp.***, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

It is the examiner's position that Nowak teaches the concept of providing a spindle on a ball, and that it would have been obvious to provide the Nowak ball with the surface



appearance of a baseball "since such a ball could be manipulated as taught by Ols [Nowak]" (Answer, page 4). We do not agree.

Nowak is directed to a multipurpose ball. In the first of the disclosed embodiments, the ball is made of elastic material and is attached to a tether or a handle so that it can be used as a punching ball, a soccer ball or a sling ball (translation, pages 4 and 5; Figures 1-10). In the second of the disclosed embodiments, the ball is of solid plastic material and is provided with openings in the shell to accommodate a continuous handle or a forked assembly so it can be used as a rolling ball (translation, pages 5 and 6; Figures 11-14). Nowak is not at all concerned with the problem upon which the appellant's invention is focused, nor does Nowak contemplate imparting spin to the ball by placing a spindle which protrudes from a bore in the ball into the chuck of an electric drill. Insofar as the structure recited in the appellant's independent claims 1 and 11 is concerned, while Nowak discloses in Figure 5 a ball having a screwed-in handle that conceivably could be installed in the chuck of an electric drill, the reference clearly fails

to disclose a ball having the surface appearance of a seamed ball.

Sain discloses a baseball pitching educational device the purpose of which is to allow pitchers to learn how to grip a ball to impart certain spins to it as it is being thrown toward a batter. The surface appearance of the ball is that of a seamed ball that is typically pitched. The ball is provided with a bore through which a shaft is inserted to protrude from the surface of the ball, but the ball is free to spin with respect to the shaft.

While the feature missing from Nowak is present in Sain, the mere fact that the Nowak ball could be modified by adding the surface appearance disclosed by Sain does not make such a modification obvious unless the prior art suggests the desirability of doing so. See ***In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In the present case, we fail to perceive any teaching, suggestion or incentive in either reference which would have led one of ordinary skill in the art to do so. We arrive at this conclusion for several reasons. First, neither baseball nor any other game in which a ball is thrown in the fashion of a baseball is contemplated by

Nowak. Second, Nowak does not disclose any particular surface appearance on the balls. Third, there would appear to be no reason or advantage to be achieved by giving any of the balls disclosed by Nowak the surface appearance of the seamed ball that is typically pitched in a baseball (or softball) game. From our perspective, the only suggestion for doing so is found in the luxury of the hindsight accorded one who first viewed the appellant's disclosure. This, of course, is not the proper basis for a rejection under Section 103. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

It therefore is our opinion that the combined teachings of the applied references fail to establish a *prima facie* case of obviousness with regard to the subject matter recited in either of the independent claims, and therefore we will not sustain the Section 103 rejection.

**SUMMARY**

Neither of the rejections is sustained.

The decision of the examiner is reversed.

**REVERSED**

IAN A. CALVERT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
NEAL E. ABRAMS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
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JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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